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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/397,503	09/17/1999	GAURAV AGGARWAL	YO999-129	8826

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05/06/2004

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EXAMINER

ZIA, MOSSADEQ

ART UNIT	PAPER NUMBER
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2134

15

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/397,503

Applicant(s)

AGGARWAL ET AL.

Examiner

Mossadeq Zia

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 September 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 7-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 7-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>Z</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, 4, 7-17, 20-29, 30, 33, 37, 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No. 5,434,917 Naccache et al., and in view of Patent No. 5,974,150, Kaish et al. and in further view of Patent No. 6,543,685 Lien et al.

3. Regarding claim 1, 33, Naccache discloses a method of guaranteeing authenticity of an object comprising:

associating a number (identity data ID) reproducibly to said sample by using a specific reader (Naccache, fig. 2, element 23, col. 2, line 57-61); and

forming at least one coded version of said number, said at least one coded version being obtained by a key signature (compute SIG(ID,p), Naccache, col. 1, line 52, 55-56),

wherein said object included at least one of a chip having a recording support, said chip positioned on said object (Naccache, col. 1, line 53), and another recording support, said method further comprising:

to allow for sample-reader combinations such that the number associated to said sample is only essentially reproducible, recording said number on said object card on said recording support on one of said chip;

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but fails providing a sample of material obtainable only by at least one of chemical and physical processes such that a measurable characteristic of said sample is random and not reproducible, and to show another recording support;

However Kaish et al. teaches that authentication of object can be performed from a particular random or non-deterministic pattern or relation of the object, preferably deterministic pattern or relation of the object, may be measured as the characteristic (sample random, Kaish, col. 9, line 21-25); and Lien et al. teaches a card encoder where one or both of the stations (recording support) needed to encoding a chip on a smart card or for adding magnetic information on the magnetic strip (another recording support) may be provided (Lien, col. 1, line 36-39).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Naccache as per teaching of Kaish and Lien to gain the benefit of obtaining a legal remedy in the case of simply copying said object (Kaish, col. 22, line 34-35) and encoding a magnetic strip on the card and adding a program into an embedded chip for "smart card" status (Lien, col.1, line 16-18).

4. Regarding claim 8, Naccache and Kaish and Lien disclose claim 1 above, further discloses reading, by a reader (Kaish, authentication device, col. 10, line 23), the sample as an initial reading of said sample, but collecting, at a time of preparation of the object, much more information about said sample that will be contained by decoding any of said coded version of that information (adaptive capabilities, Kaish, col. 10, line 41-44),

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Wherein said object carries a chip and a recording of a digital representation of the full information initially collected of the sample from the reader used at the time the object is prepared (two levels of security, physical level and information level col. 1, line 5-8).

5. Regarding claim 19, 30, Naccache and Kaish and Lien claims 1 above, and further discloses the new data and its certificate are computed dynamically (random attribute of good may be measured (implies dynamic computation), Kaish, col. 9, line 46-49).

6. Regarding claim 37, Naccache and Kaish and Lien claims 1 above, and further show wherein said forming at least one coded version of said number further comprises using additional information for said forming said coded version, wherein said additional information comprises the date of issue of said object (copyright text (date), Kaish, col. 22, line 31-33).

7. Regarding claim 38, Naccache and Kaish and Lien claims 1 above, and further show said forming at least one coded version of said number further comprises using additional information for said forming said coded version, wherein said additional information comprises the functionality of an application of said object (product identification (functionality), Kaish, col. 22, line 31-33).

8. Claims 34, 35, 36, 37 are rejected under **35 U.S.C. 103(a)** as being unpatentable over Patent No. 5,434,917 Naccache et al., and in view of Patent No. 5,974,150, Kaish et al.

9. Regarding claim 34, Naccache discloses a method of preventing imitation of a smart card, said method comprising:

associating a number (identity data ID) reproducibly to said sample by using a specific reader (Naccache, fig. 2, element 23, col. 2, line 57-61); and

forming at least one coded version of said number, said at least one coded version being obtained by a public key signature (compute  $SIG(ID,p)$ , Naccache, col.1, line 52, 55-56), and said version being recorded into an area of said object (record, Naccache, col. 2, line 53),

but fail to show wherein said sample is subject to a degeneration such that said measurable characteristic may vary over time and an authenticity of said sample is determined by calculation whether a subsequent measurement of said characteristic provides an associated number that is acceptably close to said initial reading; and

fail to show providing a sample of material obtainable only by at least one of chemical and physical processes such that a measurable characteristic of the sample is random and not reproducible;

However Kaish et al. teaches that authentication of object can be performed from a particular random or non-deterministic pattern or relation of the object, preferably deterministic pattern or relation of the object, may be measured as the characteristic (Kaish, col. 9, line 21-25). Furthermore, Kaish teaches an authentication device have adaptive capabilities to compensate for changes over time (Kaish, col. 10, line 41-44).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Naccache as per teaching of Kaish to gain the benefit of obtaining a legal remedy in the case of simply copying said object (Kaish, col. 22, line 34-35).

10. Regarding claim 35, Naccache discloses show system for guaranteeing authenticity of an object, said method comprising:

means for forming at least one coded version of said initial associated number, said at least one coded version being obtained by a public key signature, (compute  $SIG(ID,p)$ ,

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Naccache, col.1, line 52, 55-56) and said at least one coded version being recorded into an area of said object (Naccache, col. 1, line 53);

but fail to show a sample of material obtainable only by at least one of chemical and physical processes such that a measurable characteristic of the sample is random and not reproducible, said sample being placed on said object;

means for associating a number reproducibly to any said sample by using a specific reader, said specific reader providing an initial measurement of said characteristic and an initial associated number.

However Kaish et al. teaches that authentication of object can be performed from a particular random or non-deterministic pattern or relation of the object, preferably deterministic pattern or relation of the object, may be measured as the characteristic (sample random, Kaish, col. 9, line 21-25) and .

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Naccache as per teaching of Kaish to gain the benefit of obtaining a legal remedy in the case of simply copying said object (Kaish, col. 22, line 34-35).

11. Regarding claim 36, Naccache discloses show system for guaranteeing authenticity of an object, said method comprising:

means for forming at least one coded version of said initial associated number, said at least one coded version being obtained by a public key signature, (compute  $SIG(ID,p)$ , Naccache, col.1, line 52, 55-56) and said at least one coded version being recorded into an area of said object (Naccache, col. 1, line 53);

but fail to show a sample of material obtainable only by at least one of chemical and physical processes such that a measurable characteristic of the sample is random and not reproducible, said sample being placed on said object;

said wherein said sample is subject to a degeneration such that said number may vary over time and an authenticity of said sample is determined by calculating whether a subsequent associated number is acceptably close to said recorded coded version;

However Kaish et al. teaches that authentication of object can be performed from a particular random or non-deterministic pattern or relation of the object, preferably deterministic pattern or relation of the object, may be measured as the characteristic (sample random, Kaish, col. 9, line 21-25). Furthermore, Kaish teaches authentication device that has adaptive capabilities to compensate for changes over time (degeneration, Kaish, col. 9, line 42-44).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Naccache as per teaching of Kaish to gain the benefit of obtaining a legal remedy in the case of simply copying said object (Kaish, col. 22, line 34-35).

### ***Response to Amendment***

12. The applicant's amendments have been considered and are rejected by the newly listed rejections above.

### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mossadeq Zia whose telephone number is 703-305-8425. The examiner can normally be reached on Monday-Friday between 8:30am - 5:00pm.




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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Morse can be reached on 703-308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mossadeq Zia  
Examiner  
Art Unit 2134

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5/3/04

  
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